



THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

CHERYL LANIER et al.

Serial No.: 09/473,853

Group Art Unit: 3624

Examiner: C. Kyle

Filed: December 29, 1999

For: SYSTEM AND METHOD FOR UTILIZING AN EXCLUSION LIST DATABASE FOR CASINOS (As Amended)

Attorney Docket No.: FDC 0143 PUS

**APPEAL BRIEF UNDER 37 C.F.R. § 1.191
AND PETITION FOR EXTENSION OF TIME
UNDER 37 C.F.R. § 1.136(a)**

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Sir:

This Appeal Brief is in support of an appeal from the final rejection of claims 10-11 in the final Office Action mailed on April 22, 2002.

The Applicant filed a Notice of Appeal on September 23, 2002. The Applicant hereby petitions for a two (2) month extension of time to extend the time period within which to file this Appeal Brief from November 23, 2002 to January 23, 2003. A check in the amount of \$ 730.00 is enclosed herewith to cover the \$ 320.00 fee associated with the filing of this Appeal Brief pursuant to 37 C.F.R. § 1.17(c) and the \$ 410.00 fee associated with the two month extension of time pursuant to 37 C.F.R. § 1.17(a)(2).

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01 FC:1402
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I. Real Party In Interest

The real party in interest is First Data Corporation, a corporation organized and existing under the laws of the State of Delaware, and having a place of business at 401 Hackensack Avenue, Hackensack, New Jersey 07601. The original recorded assignment for this application is to First Data Corporation. The assignment was recorded on April 6, 2000, at reel 010737, frame 0567.

II. Related Appeals and Interferences

There are no other appeals or interferences known to the Applicant, the Applicant's legal representative, or the Assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 10-11 are pending in this application (reproduced for reference in the attached Appendix) and have been finally rejected and are on appeal.

IV. Status of Amendments

There were no amendments filed subsequent to the final Office Action mailed on April 22, 2002.

V. Summary of Invention

As generally described on page 3, line 13 through page 8, line 3 and FIGS. 1-2 of the Applicant's specification, the claimed invention is a method for cashing a check presented by an individual at a gambling establishment. The method includes providing a host computer (14) containing an exclusion list database (18). (See FIG. 1 and page 5, lines 15-21.) The exclusion list database (18) stores a list of individuals to be excluded

from the gambling establishment and at least one checking account identifier for each individual of the list of individuals. (See page 6, line 4 through page 7, line 10.)

In operation, an individual presents a check for cashing at a point of sale (POS) device (12) of the gambling establishment. (See FIG. 2; page 5, line 22 through page 6, line 3; and page 7, lines 11-18.) At the POS device (12), the magnetic ink character recognition (MICR) information of the check presented by the individual is scanned. The MICR information of the presented check is scanned in order to identify a checking account identifier associated with the individual presenting the check. (See FIG. 2; page 7, lines 11-22.)

The checking account identifier associated with the individual presenting the check is then transmitted from the POS device (12) to the host computer (14). (See FIG. 2 and page 7, lines 22-23.) The checking account identifier associated with the individual presenting the check is then compared with the at least one checking account identifier for each individual of the list of individuals stored in the exclusion list database (18) to determine whether the individual presenting the check is an individual to be excluded from the gambling establishment. (See FIG. 2 and page 7, lines 23-25.) The individual presenting the check is determined to be an individual to be excluded from the gambling establishment if the checking account identifier associated with the individual presenting the check matches a checking account identifier stored in the exclusion list database (18). (See FIG. 2 and page 7, lines 25-30.)

The gambling establishment prevents the check from being cashed if it is determined that the individual presenting the check is an individual to be excluded from the gambling establishment. (See FIG. 2 and page 3, lines 19-21.) Likewise, the gambling establishment cashes the presented check if it is determined that the individual presenting the check is not an excluded individual. (See FIG. 2 and page 7, line 30 through page 8, line 3.)

VI. Issue

In the final Office Action mailed on April 22, 2002, the Examiner finally rejected claims 10-11 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,679,938 issued to Templeton et al. ("Templeton") in view of Illinois Gaming Board Regulations ("Regulations"). The issue on appeal is whether Templeton in view of Regulations makes a *prima facie* showing of obviousness of claims 10-11.

VII. Grouping of Claims

Claims 10-11 stand or fall together.

VIII. Argument

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. MPEP 2143. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A *prima facie* case of obviousness has not been established if references A and B do not teach the source of the problem, and the recognition of the source of the problem is what is unobvious. *In re Kaslow*, 707 F.2d 1336 (Fed. Cir. 1983). The use of hindsight to support an obviousness rejection under 35 U.S.C. § 103(a) is impermissible. *W.L. Gore and Assocs., Inc. v Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

If an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

1. Background of the Claimed Invention

As described in the Background Art section of the Applicant's specification, a governmental authority provides a gambling establishment such as a casino with a list of individuals who are not allowed to be physically present in the gambling establishment, i.e., who are to be excluded from the gambling establishment. The governmental authority has legislated that if such excluded individuals are present in the gambling establishment, then the gambling establishment may be fined or penalized. Accordingly, the gambling establishment wants to prevent the excluded individuals from being present in the gambling establishment.

Excluded individuals may be individuals who have voluntarily placed themselves on the exclusion list in order to help them stop patronizing the gambling establishment because of gambling problems. As taught by Regulations, excluded individuals may also be individuals having criminal records and have been placed by the governmental authority on the exclusion list regardless of their volition.

The exclusion list contains information on each individual listed in the exclusion list. As described in the Background Art section and by Regulations, such information for each listed individual may include name, aliases, date of birth, address, driver's license, social security number, photograph, physical description, and personal information such as occupation.

Frequently, individual patrons of a gambling establishment present checks for cashing to the gambling establishment. This practice represents a significant means whereby the individuals gain access to cash in order to gamble in the gambling establishment. The interaction between the gambling establishment and an individual

presenting a check for cashing provides an opportunity for the gambling establishment to verify that the individual is not an excluded individual listed on the exclusion list.

Gambling establishments have taken this opportunity to determine whether an individual presenting a check for cashing is an excluded individual by manually comparing information taken from the individual such as information from the individual's driver's license with the information on the excluded list. For instance, the gambling establishment manually compares the name on the individual's drivers license with the names of the excluded individuals. If there is a match, then the individual is determined to be an excluded individual and the gambling establishment will take actions to prevent the excluded individual from staying on the premises.

Accordingly, gambling establishments have compared information taken from the individual with information associated with the excluded individuals listed in the exclusion list in order to determine if the individual is an excluded individual. A problem with the approaches taken by the gambling establishments is that the approaches do not provide a means for electronically identifying excluded individuals who present personal checks for cashing at a gambling establishment.

2. The Claimed Invention

The claimed invention as recited in independent claim 10 satisfies the above-described need. Independent claim 10 provides a method for cashing a check presented by an individual at a gambling establishment. The method includes providing a host computer containing an exclusion list database. The exclusion list database stores a list of individuals to be excluded from the gambling establishment and at least one checking account identifier for each individual of the list of individuals.

Upon an individual presenting a check for cashing at a point of sale (POS) device of the gambling establishment the magnetic ink character recognition (MICR) information of the check is scanned. The MICR information of the presented check is

scanned in order to identify a checking account identifier associated with the individual presenting the check.

The checking account identifier associated with the individual presenting the check is then transmitted from the POS device to the host computer. The checking account identifier associated with the individual presenting the check is then compared with the at least one checking account identifier for each individual of the list of individuals stored in the exclusion list database in order to determine whether the individual presenting the check is an individual to be excluded from the gambling establishment. The individual presenting the check is determined to be an individual to be excluded from the gambling establishment if the checking account identifier associated with the individual presenting the check matches a checking account identifier stored in the exclusion list database.

The gambling establishment prevents the check from being cashed if it is determined that the individual presenting the check is an individual to be excluded from the gambling establishment. Likewise, the gambling establishment cashes the presented check if it is determined that the individual presenting the check is not an excluded individual.

3. The Prior Art

Templeton is generally directed to providing a check acceptance system (10) which differentiates between good and bad checks provided by customers. (See FIG. 1; col. 12, lines 52-54.) The check acceptance system (10) includes a negative database (85) and a positive database (87). (See col. 12, lines 52-65.) The negative database (85) includes bad check data such as data indicating that previous checks tendered by a customer were bad. The negative database (85) generally appears to have bad check data associated with customers, driver's license numbers of customers who have tendered bad checks, and a list of checking accounts in which bad checks have been tendered. (See col. 13, lines 18-57; and col. 27, line 60 through col. 28, line 4.) In sum, negative database (85) includes a list of customers and/or checking accounts in which checks presented by these customers

and/or associated with these checking accounts are to be declined because of the checks having a likelihood of being bad.

Templeton further discloses using a magnetic ink character recognition (MICR) reader to read the MICR information of a check in order to obtain a checking account number. The checking account number is used to access the negative file.

Regulations discloses a gambler's exclusion list of individuals to be excluded from gambling establishments. For each excluded individual, the gambler's exclusion list may include name, aliases, date of birth, address, driver's license, social security number, photograph, physical description, and personal information such as occupation.

In the final Office Action, the Examiner posited that Templeton discloses the claimed invention including an exclusion list with the exception of the exclusion list particularly being for individuals to be excluded from gambling. The Examiner posited that Regulations discloses an exclusion list of persons to be excluded from gambling.

The Examiner posited that it would have been obvious to modify the check acceptance system of Templeton to detect the excluded individuals disclosed by Regulations and prevent cash checking because this would have allowed regulatory boards to prevent such persons from obtaining cash to gamble at establishments where such persons were prohibited from gambling. For support of the motivation to combine the teachings of Templeton and Regulations, the Examiner cited a reference regarding Mr. Frank DeSimone who is an individual to be excluded from gambling because of a criminal background which included passing bad checks.

4. The Claimed Invention Compared with the Prior Art

The Applicant believes that the claimed invention is non-obvious over Templeton and Regulations because neither Templeton nor Regulations, alone or in combination, teach the source of the problem of excluded individuals being present in

gambling establishments while having cash obtained from cashing good checks in the gambling establishments in order to be able to gamble in the gambling establishments. The recognition of the source of the problem is what is unobvious. The claimed invention takes advantage of the interaction between excluded individuals and gambling establishments which occurs when the excluded individuals present checks for cashing at the gambling establishments by preventing the checks from being cashed regardless of whether the checks are good or bad. Accordingly, the Applicant believes that the combination of Templeton and Regulations has been made using hindsight or the claimed invention itself as a template and is therefore improper.

Further, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The Examiner posited that it would have been obvious of one or ordinary skill in the art to modify the check acceptance system of Templeton to detect the excluded individuals disclosed by Regulations and prevent cash checking because this would have allowed regulatory boards to prevent such persons from obtaining cash to gamble at establishments where such persons were prohibited from gambling, i.e., the motivation of the claimed invention.

Templeton discloses a check acceptance system which uses checking account identifiers to access an exclusion list of checking accounts and/or individuals in order to prevent bad checks from being cashed. Regulations discloses an exclusion list of individuals to be excluded from a gambling establishment. There is no motivation to combine Templeton with Regulations because Templeton is directed to preventing bad checks from being cashed whereas Regulations is directed to preventing excluded individuals from being present in a gambling establishment. That is, Templeton is not concerned with whether the individual presenting the check is to be excluded from certain premises and Regulations is not concerned with whether the individual presents a check at all, and if a check is presented, whether the presented check is good or bad. Accordingly,

there is nothing contained within either of these references that would suggest their combination.

The Examiner noted that the cited reference regarding Mr. Frank DeSimone, an excluded individual, indicates that individuals accused of passing bad checks should be excluded from being present in a gambling establishment. The Examiner posited that this strengthens the motivation to combine Templeton and Regulations. The Applicant acknowledges that Mr. DeSimone's bad checks should not be cashed and that Mr. DeSimone is an excluded individual that is to be excluded from gambling establishments because of reasons including counterfeiting concerns.

However, regardless of the desire to exclude individuals convicted of passing bad checks such as Mr. DeSimone from being present in gambling establishments, the motivation to combine Templeton and Regulations is still lacking. The motivation is still lacking because Mr. DeSimone is to be excluded from gambling establishments regardless of whether he presents a check for cashing at the gambling establishments, and in the event that he does present a check, Mr. DeSimone is to be excluded regardless of whether the presented check is good or bad.

That is, in the event that Mr. DeSimone presented a good check, then the check acceptance system of Templeton would cash Mr. DeSimone's good check even though Mr. DeSimone is an excluded individual. Likewise, in the event that Mr. DeSimone presented a bad check, then the check acceptance system of Templeton would not cash Mr. DeSimone's bad check and Mr. DeSimone would likely be excluded from the gambling establishment as being labeled a "cheat" regardless of whether he already is an excluded individual. As such, the motivation to combine Templeton and Regulations in view of Mr. DeSimone is lacking because none of the references recognize the source of the problem of excluded individuals being present in gambling establishments while having cash obtained from cashing good checks in the gambling establishments in order to be able to gamble in the gambling establishments.

In view of the foregoing remarks, the Applicant believes that independent claim 10 is patentable under 35 U.S.C. § 103(a) over any combination of Templeton and Regulations. Claim 11 depends from independent claim 10 and contain the limitations thereof and, as a result, are deemed to also patentably distinguish over any combination of Templeton and Regulations.

IX. Summary

Claims 10-11 are patentable for the reasons discussed above.

Respectfully submitted,
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APPENDIX

10. A method for cashing a check presented by an individual at a gambling establishment, the method comprising:

providing a host computer containing an exclusion list database, wherein the exclusion list database stores a list of individuals to be excluded from the gambling establishment and at least one checking account identifier for each individual of the list of individuals;

receiving at a point of sale device of the gambling establishment a check presented by an individual for cashing;

scanning at the point of sale device of the gambling establishment magnetic ink character recognition (MICR) information of the check presented by the individual;

identifying a checking account identifier associated with the individual presenting the check based on the scanned MICR information of the presented check;

transmitting from the point of sale device the checking account identifier associated with the individual presenting the check to the host computer;

comparing the checking account identifier associated with the individual presenting the check with the at least one checking account identifier for each individual of the list of individuals stored in the exclusion list database to determine whether the individual presenting the check is an individual to be excluded from the gambling establishment, wherein the individual presenting the check is determined to be an individual to be excluded from the gambling establishment if the checking account identifier associated with the individual presenting the check matches a checking account identifier stored in the exclusion list database;

preventing the presented check from being cashed at the point of sale device of the gambling establishment if it is determined that the individual presenting the check is an individual to be excluded from the gambling establishment; and

cashing the presented check at the point of sale device of the gambling establishment if it is determined that the individual presenting the check is not an individual to be excluded from the gambling establishment.

11. The method of claim 10 wherein cashing the presented check includes using an additional check acceptance program.